

REMARKS**Restriction Requirement**

The application stands subject to a restriction requirement. The Examiner has designated Group I, claims 1-8, drawn to a sequence control circuit, classified in class 712, subclass 245, and Group II, claim 9, drawn to a semiconductor testing apparatus with a pattern generating circuit, classified in class 714, subclass 738.

Applicant hereby elects, with traverse, to prosecute the claims of Group I, claims 1 through 8 in this Application.

Request for Reconsideration of the Restriction Requirement

Applicant respectfully request reconsideration of the Restriction Requirement for the following reasons.

In the Office Action, the Examiner alleged as follows:

Inventions Group I and Group II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because a sequence control circuit can be used in semiconductor testing apparatus along with other aspects such as pattern memory, pattern generators and determination circuitry. The subcombination has separate utility in circuitry having nothing to do with testing such as instruction processing in various types of circuitry.

However, the Examiner is respectfully drawn his attention to Applicant's Amendment filed on March 12, 2004 in which a combination (claim 9) was amended to set forth all of the limitations, i.e., particulars of the subcombination (claim 1), as presented in the listing of claims

as the current form (with the status identifier “Withdrawn” because of the election requirement). Thus, claim 9 requires all of the particulars of the subcombination as claimed for patentability. In addition, the Examiner’s allegation that “a sequence control circuit can be used in semiconductor testing apparatus along with other aspects such as pattern memory, pattern generators and determination circuitry” merely states that subcombination may have a separate utility. Thus, the condition (1) above is not satisfied. It should be noted that MPEP §806.05(c) cited above requires both of the conditions (1) and (2) be satisfied for the restriction requirement to be proper.


MPEP §806.05(c) II specifically provides that where the relationship between the claims is such that the separately claimed subcombination B_{sp} (“sp” stands for specific characteristics set forth in the subcombination; claim 1 in the present case) constitutes the essential distinguishing feature of the combination AB_{sp} as claimed (claim 9, in the present case), the inventions are not distinct and a requirement for restriction must not be made, even though the subcombination has separate utility.

Accordingly, Applicant respectfully asserts that the Examiner’s restriction requirement is improper, and respectfully request that claim 9 be considered in this application along with elected claims 1 through 8.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Respectfully submitted,
THELEN REID & PRIEST LLP

Dated: May 24, 2004


Masako Ando
Limited Recognition Under 37
CFR §10.9(b)

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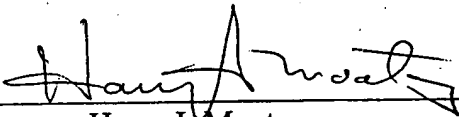
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Expires: August 27, 2004



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Director of Enrollment and Discipline